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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------|-------------|----------------------|---------------------|------------------|
| 09/744,904 | 01/31/2001 | Mamoru Takahashi | 1155-0214P | 8530 |
| 2292 | 7590 | 04/11/2005 | EXAMINER | |
| BIRCH STEWART KOLASCH & BIRCH | | | LEE, RIP A | |
| PO BOX 747 | | | ART UNIT | |
| FALLS CHURCH, VA 22040-0747 | | | PAPER NUMBER | |
| | | | 1713 | |

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|---|--------------------------------------|---|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 09/744,904 | Applicant(s) TAKAHASHI ET AL. | |
| | Examiner Rip A. Lee | Art Unit 1713 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED February 23, 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1, 3-28 and 34-43.

Claim(s) objected to: 30-33.

Claim(s) rejected: 29.

Claim(s) withdrawn from consideration: 44-77.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☒ Other: attachment to advisory action.

Attachment to Advisory Action

This advisory action follows a response filed on February 23, 2005. Applicants traverse the remaining rejection of claim 29 under 35 U.S.C. 102(b) as being anticipated by U.S. 5,260,384 (Morimoto *et al.*).

Applicants have provided rationale to show why the relationship between melt flow ratio (MFR) and intrinsic viscosity ($[\eta]$) does not satisfy the inequalities set forth in the claim. The examiner has reviewed Applicant's discussion carefully. Applicant's approach is logical, however, it is based on several premises that appear to have no support in the patent (the examiner could not find the information in Morimoto *et al.*).

First, it is not clear which data provides the notion that $MFR_{2.16}$ is about 0.01 g/10 min when MWD is 10 and $MFR_{21.6}$ is about 2.9 g/10 min (page 6 of response). It is also noted that the relationship between MFR and MWD is an empirical one, being dependent on the nature of the polymer in question. Two different polymers may exhibit different MWD/MFR relationships. That said, it is not clear how the extrapolation that "there is a reasonable expectation that is much higher than 0.0075 g/10 min" can be drawn. That is, it is not clear how the above data (for some unspecified polymer) applies to the polymer of example 4 of Morimoto *et al.* Even if these data could apply to both polymers, the question remains as to how one arrives at the limit of 0.0075 g/10 min because the relation between MWD/MFR does not appear to be a linear one.

Secondly, it is not clear how the tabulated information in Table 3 is derived. Since this is the core of Applicant's two-prong approach to their conclusion, supporting information needs to be furnished. While the examiner does not disagree with the assumption that polymers A2 and B1 are likely to have MWD greater than 4, it is noted that this is an assumption and nothing more. Applicants would be prompted to provide supporting information for arriving at this notion *with respect to the polymer of example 4 of the prior art.*

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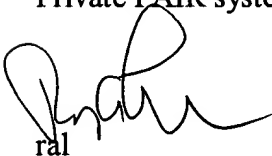
Art Unit: 1713

In conclusion, Applicants approach to the problem is logical and the conclusion flows naturally from the information proffered in the response. However, it is based on several facts which, to date, are insufficient in providing a preponderance of evidence in Applicant's favor. The examiner encourages Applicants to submit further information, and if necessary, to schedule an interview should an verbal explanation prove more effective than a written response.


In view of these facts, the rejection of record remains in force.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


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April 7, 2005


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